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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/000,325      | 12/04/2001  | Michael S.H. Chu     | -06530.0285-00000.  | 9761             |

7590 07/30/2004

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EXAMINER

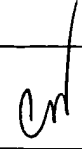
THALER, MICHAEL H

| ART UNIT | PAPER NUMBER |
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3731

DATE MAILED: 07/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                                      |   |  |
|------------------------------|--------------------------------------|---|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>10/000,325 | <b>Applicant(s)</b><br>CHU, MICHAEL S.H.  |  |
|                              | <b>Examiner</b><br>Michael Thaler    | <b>Art Unit</b><br>3731   |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 25 May 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-60 is/are pending in the application.
- 4a) Of the above claim(s) 40-60 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-39 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>1/17/02, 12/20/02</u> . | 6) <input type="checkbox"/> Other: _____  |

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Claims 40-60 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on May 25, 2004.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 9 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 9 depends from claim 9.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at

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the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-4, 8-10, 14-19, 22-26, 31-34, 38 and 39 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Mitsuru (Japan JP6343599). Mitsuru, in figures 5, 6A and 6B, discloses elongate member (either 10 or 20) for insertion into a channel of the endoscope 50, distal assembly 70 having an open configuration (figure 6B) and a closed configuration (figure 6A) with a profile larger than a diameter of the channel of the endoscope 50 (noting that the profile of distal assembly 70 has a diameter which is larger than the diameter of the channel of the endoscope 50 as seen in figure 6A). As to the language "configured to be loaded into a channel of an endoscope" in claim 1, lines 1-2, which require the endoscopic device to be capable of existing outside of the channel of an endoscope, it is unclear if the Mitsuru endoscopic device, once assembled with the endoscope during manufacture, is detachable from the endoscope. However, assuming *arguendo* that it is not detachable, the endoscopic device, in the state prior to its' assembly into the endoscope during manufacture meets the terms of the claims. Alternatively, it would have been obvious that it is configured to be loaded into a channel of an endoscope for

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this reason. As to claim 3, Mitusuru discloses a member near the proximal end of the elongate member at the handle which inherently acts as a stop. As to claim 8, activation shaft (e.g. 20) is inherently capable of rotating the distal assembly when the activation shaft is rotated. As to claim 9, the distal end of the activation shaft is bent when it is in a curved path in the body. As to claim 10, the distal assembly is inherently capable of obtaining and storing multiple small samples. As to claim 15, Mitusuru discloses ring 22. As to claim 26, Mitusuru discloses extension (the proximal portion of 10 extending proximally from 50 as seen in figure 5).

Claims 5, 6, 11-13, 20, 21, 27-30, 35-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mitsuru (Japan JP6343599). As to claims 5, 6, and 27-29 Mitsuru fails to disclose the details of the handle with the slide. However, it is old and well known in this art to so construct handles for reliably and smoothly activating surgical end effectors. It would have been obvious to so construct the Mitsuru handle at 60 so that it too would have this advantage. As to claims 7, 11-13, 20, 21, 30 and 35-37 Mitsuru fails to disclose the details of the elongate member. However, it is old and well known in this art to so construct elongate members for reliably and smoothly activating surgical end effectors. It would have been

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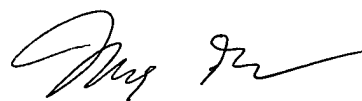
obvious to so construct the Mitsuru elongate member so that it too would have this advantage.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Thaler whose telephone number is (703) 308-2981. The examiner can normally be reached Monday to Friday.

The fax phone number for the organization where this application or proceeding is assigned is (703)872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-0858.

mht  
7/28/04



MICHAEL THALER  
PRIMARY EXAMINER  
ART UNIT 3731